

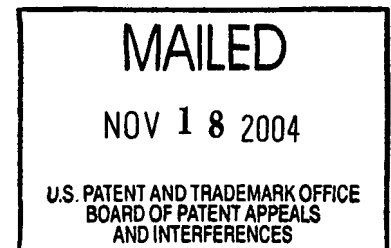
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID J. KINSELLA

Appeal No. 2003-1834
Application No. 09/584,162

ON BRIEF



Before FLEMING, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

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DECISION ON APPEAL

A patent examiner rejected claims 1, 2, 7-24, 49-58, 60, 61, and 67-81. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse and remand.

BACKGROUND

The invention at issue on appeal uses a biometric sensor, e.g., a fingerprint sensor, to verify the identity of a user of an electronic system. Persons need to be identified for many reasons, e.g., to limit access to bank accounts or to secure facilities.

Such needs have led to a proliferation of identification cards, passwords, and personal identification numbers that persons must carry or memorize. (Spec. at 1-2.)

In contrast, the appellant's invention incorporates a biometric sensor into a pointing device. When operating the device, one of the user's fingers naturally rests near the sensor. The sensor reads the user's fingerprint and generates identifying data therefrom. Along with positional data from a location sensor and selection data from a button, the pointing device conveys the identifying data to an attached system. An audit log records attempted transactions, authorized and denied. Because the invention uses a familiar pointing device, the appellant asserts that "[m]inimal technical knowledge is required" to use the device. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A pointing device comprising:

an interface for operably communicating with an electronic system;

a position sensor, responsive to user movement thereof, for conveying positional information by way of said interface to the electronic system;

a user-depressible button for conveying selection information by way of said interface to the electronic system;

a biometric sensor disposed at a location such that when operating said pointing device in a normal manner a user's hand rests naturally in a position to place a finger of the user's hand in proximity to and readable by said biometric sensor; and

a verification system for operably communicating with the electronic system, the verification system comprising a user storage, an authorization profile storage, and an audit log storage, the audit log storage being configured to store:

(a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and

(b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within said electronic system.

Claims 1, 2, 10, 11-14, 49-56, and 60 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,229,764 ("Matchett") and U.S. Patent No. 5,513,272 ("Bogosian"). Claims 7-9, 20, and 21 stand rejected under § 103(a) as obvious over Matchett, Bogosian, and the appellant's admitted prior art ("AAPA"). Claims 15-19 stand rejected under § 103(a) as obvious over Matchett, Bogosian, and U.S. Patent No. 5,703,356 ("Bidiville"). Claims 22-24 stand rejected under § 103(a) as obvious over Matchett, Bogosian, and U.S. Patent No. 5,838,306 ("O'Connor"). Claims 57 and 58 stand rejected under § 103(a) as obvious over Matchett, Bogosian, and U.S. Patent No. 5,337,358 ("Axelrod"). Claims 61 and 67-81 stand "rejected as claims 1-24 and 49-60,

because [the] claims . . . are claiming similar subject matter as claims 1-24 and 49-60."

(Examiner's Answer at 12.)

OPINION

Our opinion addresses the claims in the following order:

- claims 1, 2, 7-24, 49-58, and 60
- claims 61 and 67-81.

A. CLAIMS 1, 2, 7-24, 49-58, AND 60

Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the main point of contention therebetween. The examiner asserts, "Bogosian in col. 5, lines 24-33, states that if a users fingerprints does *not match* 'denial of' to the stored fingerprints the fingerprints will be stored, for the purpose of determining any criminal activity. Also, the recording of the fingerprint corresponds to the unsuccessful attempt i.e. 'attempted transaction' as claimed." (Examiner's Answer at 14.) The appellant argues, "Bogosian *never* stores a fingerprint along with attempted transaction information because Bogosian does not allow *any* transaction to be attempted within a system once the fingerprint is taken." (Appeal Br. at 12.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

1. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). "[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. *[T]he name of the game is the claim. . . .*" *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, *The Extent of the Protection and Interpretation of Claims --American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)).

Here, claim 1 recites in pertinent part the following limitations: "the audit log storage being configured to store: (a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and (b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within

said electronic system." Accordingly, the independent claim requires **both** storing user identifying data when access to an electronic system is denied **and** storing user identifying data and transaction identifying data when access to a specific transaction of the system is denied.

2. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner admits, "Matchett fails to disclose . . . [any] audit log storage. . . ." (Examiner's Answer at 3.) For its part, Bogosian discloses "a method and

apparatus for verifying an authorized user of a credit/identification card." Abs., ll. 1-3.¹

One "step of the method . . . requires the user of the card 12 to provide a fingerprint 18 which is compared to the fingerprint 18 on the card 12 and to a fingerprint of the owner of the card in the aforementioned database 44. . . ." Col. 5, ll. 7-11.

"[I]f the fingerprint scanned by the fingerprint scanning station does not match the fingerprints on the card and in the database 44," *id.* at ll. 15-18, the card is confiscated. *Id.* at l. 15. In such an event, the method also "record[s] the fingerprint of the user." *Id.* at ll. 27-28. "The purpose of this additional step is to obtain evidence which could possibly be used to identify the unauthorized user of the card." *Id.* at ll. 28-30. The secondary reference's recording of a fingerprint of an unauthorized user teaches the claimed storage of user identifying data when access to an electronic system is denied.

We are unpersuaded that Bogosian can deny access to a specific transaction, however, let alone store user identifying data and transaction identifying data in response to such a denial. To the contrary, "[i]f the fingerprint of the user matches the

¹"The method 10 may also be used to verify the identity of authorized persons desiring access to a restricted area (e.g., hospitals, corporate research facilities, etc.)." Col. 4, ll. 9-12.

fingerprints on the card 12 and in the database 44, the apparatus 22 may allow the user to use the card 12 for a desired purpose, or . . . the card 12 may be examined by subsequent stations if a more exacting level of verification is required." *Id.* at ll. 18-23. "[I]f additional verification is necessary, the card 12 may be examined by the voice print recording station 36, the retinal scanning station 38 and the photograph scanning station 40." *Id.* at ll. 34-37. Upon verification by the stations, "the verification process is complete," col. 6, l. 19, and "the apparatus will allow the user to use the card for a desired purpose. . . ." *Id.* at ll. 18-19. In other words, once the secondary reference completes verification of a user's identity, the authorized user may use the card for any transaction he desires. No further, transaction-specific verification is contemplated. Absent a transaction-specific verification, Bogosian cannot deny access to a specific transaction, let alone store user identifying data and transaction identifying data in response to such a denial.

The examiner does not allege, let alone show, that the addition of AAPA, Bidiville, O'Connor, or Axelrod cures the aforementioned deficiency of Matchett and Bogosian. Absent a teaching or suggestion of storing user identifying data when access to an electronic system is denied and storing user identifying data and transaction identifying data when access to a specific transaction of the system is

denied, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claim 1 and of claims 2, 7-24, 49-58, and 60, which depend therefrom.

B. CLAIMS 61 AND 67-81

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). "For each rejection under 35 U.S.C. 103, the examiner's answer . . . shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection. . . ." M.P.E.P. § 1208 (8th ed. Aug. 2001).

Here, the examiner rejects claims 61 and 67-81 "as claims 1-24 and 49-60, because [the] claims . . . are claiming similar subject matter as claims 1-24 and 49-60." (Examiner's Answer at 12.) Claims 1, 2, 7-24, 49-58, and 60, however, have been rejected under five different combinations of references, *supra*. Furthermore, claims 3-6 and 59 have been canceled. (Appeal Br. at 4.)

For their part, claims 61 and 67-70 require limitations similar to those of claim 1, *supra*. Absent a showing that any combination of Matchett, Bogosian, AAPA, Bidiville, O'Connor, or Axelrod teaches or would have suggested storing user identifying data when access to an electronic system is denied and storing user identifying data and transaction identifying data when access to a specific transaction of the system is denied, we reverse the obviousness rejection of claims 61 and 67-70.

The limitations of claims 71-81, however, appear broader than those of claim 1. Neither independent claim 71 nor independent claim 79, for example, seems to require storing user identifying data when access to an electronic system is denied and storing user identifying data and transaction identifying data when access to a specific transaction of the system is denied.

We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we remand the application to the examiner to prepare a supplemental examiner's answer. The supplemental answer should specify which combinations of references are relied on to reject each of claims 71-81. It should also point out where each of the specific limitations recited in

claims 71-81. Particular attention should be directed to where the claimed "authorization profile" and "audit log storage" are found in the individual references.

Furthermore, the supplemental answer should be self-contained with respect to all rejections and arguments. No prior examiner's answer or Office action should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellant should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

CONCLUSION

In summary, the rejections of claims 1 and of claims 2, 7-24, 49-58, 60, 61, and 67-70 under § 103(a) are reversed. The rejection of claims 71-81, however, is subject to a remand.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

REVERSED and REMANDED


ANITA PELLMAN GROSS
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

~~LANCE LEONARD BARRY~~
~~Administrative Patent Judge~~

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THOMPSON & KNIGHT L.L.P.
PATENT PROSECUTION DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1900
AUSTIN, TX 78701